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10/763,635	01/22/2004	Duane Sweeney	6042P002	7713
8791 7590 09/18/2008 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
VANDERHORST, MARIA VICTORIA				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/763,635

**Applicant(s)**

SWEENEY ET AL.

**Examiner**

M. VICTORIA VANDERHORST

**Art Unit**

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 01/22/2004
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **Status of Claims**

This communication is in response to application No. 10/763635, filed on 01/22/2003

Claims 1-27 are currently pending and have been examined.

Claims 1-27 have been rejected.

### ***Drawings***

1. The drawings are objected to because of the following informalities:

Regarding to Fig. 3, the specification makes reference to "If it is determined at operation 62 that the offering category appears in the user profile...". Fig. 3 does not contain the mentioned references 62. Further, Fig. 3 has operation 56 that is not described on the specification. Regarding to Fig. 4, there are two reference numbers (operations) with the same number "If the user profile exists at operation 148, the user profile is updated with the selected category at operation 148...". Corrected drawing sheets or amendment to the specification to deleted the reference character(s) from the description in compliance with 37 CFR 1.121(d) is required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the

appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. Appropriated correction is required.<sup>3</sup>

### **Claim Objections**

Regarding to **claim 23, 24 and 25**, it appears that the claims dependent of claim 10. Claims recitations is not further limiting claim 13.

2. **As to claims 23, 24 and 25**, are objected to because of the following informalities: It seems, claims 23, 24 and 25, are dependent from claim 10 and not from claim 13. For examination purposes the Examiner treats on the merits claims 23, 24 and 25 depending from claim 10. If this is the case Examiner suggests checking for redundancy that may render these claims indefinite. Appropriate correction is required.

### **Examiner's Remarks /Comments**

3. As to claim 1, 14 and 27 Applicant recites i.e., "... a rewards module to reward the user if the user satisfies a reward criteria ...." Language that suggests or makes optional, but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP 2106 IIC). The appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-13, 23-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**As to claim 1**, it recites a system comprising a series of "module". These "module" limitations are functional descriptive material. Further, claim 1 does not recite that this "software" (logic module or software) is recorded on a computer readable medium, employed as a computer component, etc. Therefore, it is respectfully submitted that claim 1 is non-statutory because, as per MPEP 2106, descriptive material is non-statutory when claimed as descriptive material per se and not functionally and structurally interrelated to a medium.

**As to claims 2-13 and 23-26**, they depend from claim 1 and do not cure the deficiencies set forth above. Therefore, claim 2-13 and 23-26 are also rejected for being directed to non-statutory subject matter.

6. Claims 14-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**As to claims 14 and 27**, they are rejected under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 14 and 27 fail to meet the above requirements because the claims fail to tie in another statutory class of invention.

**As to claims 15-22**, they depend from claim 1 and do not cure the deficiencies set forth above. Therefore, claim 15-22 are also rejected for failing to tie in another statutory class of invention.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-13, 23-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Moreover, the word "if" in the claims suggest or makes the steps optional but does not require any steps to be performed.

**As to claim 1**, it recites in the preamble that the claim is directed towards the statutory category of a system. However, the body of the claim 1 comprises a series of " module or software ", and thus is directed towards functional descriptive material. Therefore, it is not clear how a series of "module " (or functional descriptive material) constitutes a system. Clarification is required.

**As to claims 2-13 and 23-26**, they depend from claim 1 and contain the same deficiencies. Therefore, claims 2-13 and 23-26 are also rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Clarification is required. For examination purposes, Examiner has construed the system to contain a combination of software and hardware elements.

9. Claims 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**As to claim 26**, the same limitation "...detecting a spam complaint from the user; identifying a provider associated with the spam complaint; and taking an action in

response to the spam complaint..." is already inherited from claim 13. The redundancy renders the claim indefinite. Examiner suggests deletion of this limitation in the claim.

**As to claim 27**, the claim recites that is a method but it has claim limitation expressed in means-plus function language. The recitation of the claim is claiming structure that accompanies a system "means for". It is not clear how a method can contain "means for" (MPEP 2181). Clarification is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claim 1-3, 8, 14-16 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,980,962 Arganbright et al.

**As to claims 1 and 14**, Arganbright discloses a system and method to facilitate computer-based commerce (**Abstract**), the system including:

an offering dispatch module to facilitate communicating a provider offering to a user if the offering is within a category designated by the user as being acceptable for receipt of such offering (**Arganbright discloses a method for facilitating e-commerce. In one embodiment of his method the marketing company may offer**



an extensive selection of products by catalog (arranged in categories and sub-categories), Col. 56:5-47, Col. 56:61-67, Col. 57:51-67, and Col. 58:1-5. Further, Arganbright states that one of the ways to present an offer to a customer is through the electronic medium (email) and the internet, Col. 32:35-46. Furthermore, his method has several kind of members (customers) each of them is presented with different information, Col. 38:1-48. In addition, Arganbright indirectly discloses that his customers accept offering that provided from his method because they have to be registered. His method comprises individuals that have been registered as client, member, member plus or Independent Business Owner(BO), Col. 2:17-47, Col. 22:55-67, Col. 23:1-10. Furthermore, his method creates profiles and personalized messages to his customers, Col. 10:51-65, Col. 11:22-44); and

a rewards module to reward the user if the user satisfies a reward criteria (Arganbright's method comprises a rewards database, Col. 2:43-67, Col. 3:1-58), the reward criteria including the user propagating the provider offering to a second user (Arganbright's method comprises some customer categories that sponsor other customers propagating offers and increasing sales in a non conventional multilevel marketing system, Figs. 3 and 22, Col. 11:58-60, Col. 12:36-38, Col. 23:11-36. Further, his method comprises a "virtual office" that provides support to members plus and BOs, so they can propagate offerings customized to their clients preferences, Col. 11:22-44, Col. 23:61-67, Col. 1-26. Furthermore, member plus and BOs are entitled to a "performance bonus" between other rewards

according with a reward criteria established for those kind of customers, Col. 27:46-67, Col. 28:1-60).

As to claims 2 and 15, Arganbright discloses a system and method according with claims 1 and 14 above, and Arganbright further discloses a user profile monitor to maintain a user profile ( Arganbright discloses a “member Perks” functionality that allows a member to personalize information for the shopping environment based on the user’s profile, Col. 63:56-67, Col. 64:1-22, Fig. 16), the user profile including one or more user selections from a plurality of categories, each selection associated with an area of interest ( Fig. 17, Arganbright’s system comprises a profile to limit and personalize products and services, Col. 64:31-64. In addition, his system incorporates a plurality of categories, Col. 65:16-54, Col 60:49-63, Figs. 1, and 20);

a vendor communication module to detect receipt of the provider offering (“The present invention is also directed to providing Independent Business Owners in a marketing business with a “Virtual Office” feature that provides information vital to the operation of their business. Preferably, the Virtual Office feature is embodied in an office page web file associated with the web site of the present invention. The information provided includes, but is not limited to, information on different product offerings...”, Col. 23:48-67 ); and

an offerings monitor in communication with the provider communication module to identify the offering as associated with an offering category and to store the offering in an offerings database ( Arganbright indirectly discloses that the offerings are

store in a database but his system has functionality and capability to display the offering products by category, Figs. 9, 10 and 20. Further, his system stores an identification number associated to each product and service provided ('SKU') Col. 38:49-54 ).

As to claims 3 and 16, Arganbright discloses a system and method according with claims 1 and 14 above, and Arganbright further discloses wherein the communicating of the provider offering to the user being without revealing the user's contact information or the user's identity to the provider (Arganbright indirectly discloses that the users or clients' identity are not communicated to the provider. He discloses that his multilevel marketing system has a BIO (a kind of customers), who performs retailing efforts to reach more customers or clients (users) for sale, Col. 29:9-26. In addition, the IBO has complete access to the Virtual Office site to provide tools such as e-mail to assist managing and monitoring their E-Commerce business. Access to personalized information of his clients as well as access to great merchandizing offers, is also provided to the IBO, Col. 28:09-19).

As to claims 8 and 20, Arganbright discloses a system and method according with claims 2 and 15 above, and Arganbright further discloses wherein the user profile is independent from the user's communication service provider ( Arganbright discloses that his user profile is independent of the communication service

**provider, “In a preferred embodiment, membership authentication and personalization information is stored in a central repository on the server computer...” (Col. 46:54-59).**

**Further, in his system there are market products that fall in the category “Other Products” . “these products may include catalog items as well as a link to the marketing company-sponsored Internet Service Provider...” , Col. 60:29-63 ).**

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 4-7, 9-13, 17-19 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,980,962 Arganbright et al in view of U.S. Patent 7,340,401 Koening .

**As to claim 4**, Arganbright discloses a system and method according with claim 2 above, and Arganbright further discloses a user communication module in communication with the user profile monitor to receive a selection from the user and to store the selection in the user profile ( **“In addition, by building customer profiles and personalizing messages to individual customers, the present invention may allow the marketing company to increase sales of the existing products to current**

**customers...”, Col. 10:42-65. Further, Arganbright’s system discloses “ this profile determines how the site is rendered to the registered shopper, including what product, price, services and merchandizing the shopper sees...”, Col. 46:60-67).** But Arganbright does not disclose wherein the selection includes one or more of adding a category and removing a category.

However, Koenig discloses on a system for order and deliver products. His system allows selecting a product category and presenting the products. Further, the customer can alter their profile while logged on to the transaction facilitator website (**Col 7:20-39, Fig. 3).**

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of Koenig with Arganbright’s teachings because a merchant would perceive an increase in customer satisfaction since the system is flexible enough to adjust to the customer’s needs.

**As to claims 5 and 17**, Arganbright and Koenig disclose a system and method according with claims 4 and 15 above, and Arganbright further discloses an intelligent agent to: identify a related category associated with the selection of the at least one category; identify a product associated with the related category; and publish the associated product to the user (**Fig. 20, Col. 32: 35-46, Col. 38:49-54, Col. 65:35-54 ).**

**As to claims 6 and 18**, Arganbright and Koenig disclose a system and method according with claims 5 and 17 above, and Arganbright further discloses a system

wherein intelligent agent being to invite the user to select the related category to be included in the user profile, responsive to identifying the user as being interested in the associated product ( Arganbright's system comprises "keep me posted" functionality where customers are notified if new products are available. Arganbright, indirectly discloses identifying the user as being interested. Users are interested because they have to fill out a form to be considered in the list of "keep me posted" customers, Col. 45:10-24 ).

As to claims 7 and 19, Arganbright discloses a system and method according with claims 2 and 15 above, and Arganbright further discloses including a statistics generator ( Col. 44:56-61). But Arganbright does not disclose to automatically generate a value associated with a number of user profiles identified as including the offering category.

However, Official Notice has been taken that is old and well known in the art to provide capability or functionality to a system that facilitates e-commerce transactions for statistics and demographics, so the users of the system can evaluate the trending or demand for an specific category of products and evaluate posted prices. For example **Eric T. Andersen et al. Are Sale Signs Less Effective When More Products Have Them? Marketing Science, Vol. 20, No. 2, 2001, pp 121-142**, elaborates on a model using statistics to evaluate a women's clothing catalog between other products. His analysis allows evaluate the incidence of "sale" signs on the demand of this kind of products.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of Arganbright with the commonly recognized practice of producing statistics and demographics, in this specific case generating statistics with the number of users (profiles ) per category of items offered, because statistics are a good decision tool for the system stakeholders.

As to claims 9 and 21, Arganbright discloses a system and method according with claims 2 and 15 above and Arganbright further discloses wherein the offering dispatch module is to:

detect a change to the user profile (Col. 51:34-48),

identify the change as an additional category in the user profile ("Once a user has registered, they are also able to modify their profile information. It is preferred that the profile information is passed back to the host system or server computer for retention...", Col. 51:34-48),

identify a new interest offering in the offerings database, the new interest offering associated with the additional category in the user profile (Arganbright discloses "In addition, a personal profile input form may be included within each of the shopping page web files associated with the E-Commerce web site. This form can be a questionnaire or other suitable form that a shopper completes and submits that provides information about their lifestyle, shopping, or product preferences. The system reviews the form and provides product recommendations to the customer...", Col. 55:5-46 ), and

facilitate communicating the new interest offering to the user ("In addition, as a subset of personalizing the site, shoppers can be provided with an e-mail notification with a digital coupon. The email contains an explanation of the coupon and a link that brings the user to the E-Commerce web site. It can also automatically add the item to the shopping basket and apply the coupon against the shopping basket...", Col. 55:5-46 ).

As to claim 10, Arganbright discloses a system and method according with claim 1 above and Arganbright further discloses wherein the reward criteria includes one or more events resulting from the user propagating the provider offering to the second user the one or more events selected from a group including (Arganbright discloses that his system has functionality to grant rewards, Col. 3:37-58. Further, since his system has the IBOs as a kind of customer, they can propagate information on different product offerings to their customers (second users), Col. 23:61-67, and Col. 24:1-26)

receiving a completed survey from the second user;

receiving an indication of a purchase by the second user (in Arganbright's system the IBOs sell products to a second customers, Col. 28:33-60. Further, in his system a close follow up of merchandise or services sold to customers is done because each distributor is part of the multilevel compensation capability that his system has, Fig. 2, Col. 29:9-26 );

receiving an indication of a click through by the second user; and



receiving a testimonial from the second user.

**As to claim 11**, Arganbright discloses a system and method according with claim 1 above and Arganbright further discloses, wherein the reward includes one or more items selected from a group including a credit value, one or more points, and a monetary value (**Fig. 2, Col. 29:9-26**).

**As to claim 12**, Arganbright discloses a system and method according with claim 1 above and Arganbright further discloses, wherein the reward being designated to the user or a third party (**Arganbright's system has multiple rewards for the different customers, Col. 2:43-67, Col. 3:16-58, discounts in products for IBOs, Fig. 8b, 8c and 9.** ).

**As to claim 13**, Arganbright discloses a system and method according with claim 1 above and Arganbright further discloses, including a spam control module in communication with the offerings monitor to receive a spam complaint, to identify a user associated with the spam complaint, and to take an action in response to the spam complaint (**Arganbright's system comprises an anti-virus software (including e-mail protection), Col. 38:65-67, Col. 39:1-32 )**).

**As to claim 23**, it contains limitations already addressed in rejected claim 10 above. The claim is rejected in like manner.

**As to claim 24,** it contains limitations already addressed in rejected claim 11 above. The claim is rejected in like manner.

**As to claim 25,** it contains limitations already addressed in rejected claim 12 above. The claim is rejected in like manner.

**As to claim 26,** it contains limitations already addressed in rejected claim 13 above. The claim is rejected in like manner.

**As to claim 22,** Arganbright discloses a system and method according with claim 15 above and Arganbright further discloses wherein the awarding of the reward to the user includes: identifying the provider offering as a propagated offering; and updating the propagated offering with the offering data stored in the offerings database (**Arganbright indirectly discloses that the offerings are updated in the database. "The information provided includes, but is not limited to, information on different product offerings". Col. 23, 61-67, Col. 24:1-26).**

**As to claim 27,** it contains limitations already addressed in rejected claim 1 above. The claim is rejected in like manner.

#### **Point of Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. VICTORIA VANDERHORST whose telephone number is (571)270-3604. The examiner can normally be reached on regular.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571 272 6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. V./  
Examiner, Art Unit 3688

/Raquel Alvarez/  
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